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| APPLICATION NO.                           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 09/772,324.                               | 01/26/2001  | Saul R. Dooley       | GB 000062              | 7672             |
| 24737                                     | 7590        | 07/06/2005           | EXAMINER               |                  |
| PHILIPS INTELLECTUAL PROPERTY & STANDARDS |             |                      | PARTHASARATHY, PRAMILA |                  |
| P.O. BOX 3001                             |             |                      | ART UNIT               | PAPER NUMBER     |
| BRIARCLIFF MANOR, NY 10510                |             |                      | 2136                   |                  |

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                         |  |
|------------------------------|--|-------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>                   | <b>Applicant(s)</b>     |  |
|                              | 09/772,324                               | DOOLEY, SAUL R.         |  |
|                              | <b>Examiner</b><br>Pramila Parthasarathy | <b>Art Unit</b><br>2136 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 April 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 5,9,10,17,21-23 and 40-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 5,9,10,17,21-23 and 40-42 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 1/26/01 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Original application contained Claims 1 – 39. Applicant added Claims 40 – 42. Applicant cancelled 1 – 4, 6 – 8, 11 – 20 and 24 – 30. Therefore, presently pending claims are 5, 9, 10, 21 – 23 and 40 – 42.

2. Applicant's submission filed on May 04, 2005 has been entered and made of record.

### ***Response to Remarks/Arguments***

3. Applicant's arguments with respect to claims 5, 9, 10, 21 – 23 and 40 – 42 have been fully considered but they are not persuasive for the following reasons:

***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show MS3 as described in the specification (Paragraph [0016 and 0018]). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 40 recites the limitation "the first" in line 3. There is insufficient antecedent basis for this limitation in the claim. Examiner broadly interprets this as the device.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 5, 9, 17, 21 – 23 and 40 – 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 – 26 of Dooley et al. (U.S. Patent No. 6,646,603, hereafter “Dooley”). Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example, as follows:

7. Claim 40 of instant application recites: A device comprising:

(1) a transmitter for sending a request for location information to a recipient external to the device in the event that the device is unable to determine its location;

(2) a receiver for receiving location information from that recipient; and

(3) a processor for processing received as processing received location information to generate an estimate of the device's own location.

8. Claim 18 of the Patent recites: A device able to provide an estimate of its location comprising:

(1) ranging means for obtaining at least one range measurement from the device to a first reference point and location information of the first reference point;

(2) a receiver for receiving ranging information relating to at least one range measurement from another device, located near the device and thus essentially at the same location, to a second reference point and location information of the second reference point; and

(3) a processor for resolving clock errors of the first and second devices and calculating an estimate of the location of the device using both the range measurements obtained by its ranging means and from the ranging information, and wherein at least one range measurement obtained from the ranging information was obtained with respect to a reference point to which no range measurements were obtained by the ranging means.

9. Claim 19, dependent on Claim 18 of the Patent recites: A device according to Claim 18 further comprising:

(4) a transmitter for transmitting the estimate of the location of the device to the other device located nearby.

10. As underlined above, the limitation of both instant application and the patent recite the exact language. However, the limitations (1), (2), (3) and (4) of the patent claim range measurement and further calculating the estimated location information. It is clearly that the limitations of (1), (2) and 3 of the instant application are more specific comparing to the limitation of (1), (2), (3) and (4) are more generic. Therefore, it is clear that Claims 5, 9, 17, 21 – 23 and 40 – 42 of the instant application anticipate Claims 1 – 26 of the Patent.

11. "Claims 1, 17 and 40 in the instant application are generic to the species of claims 1 and 18 in the Patent. Thus, the generic invention is "anticipated" by the species of the copending application invention. Cf., Titanium Metals Corp. v.

Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting."

*(In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).*

**12.** Claims 5, 9, 10, 17, 21 – 23 and 40 – 42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 – 27 of copending Application No. 20040027283. Although the conflicting claims are not identical, they are not patentably distinct from each other because as follows.

**13.** Claim 40 of instant application recites: A device comprising:

- (1) a transmitter for sending a request for location information to a recipient external to the device in the event that the device is unable to determine its location;
- (2) a receiver for receiving location information from that recipient; and
- (3) a processor for processing received as processing received location information to generate an estimate of the device's own location.

14. Claim 19 of the copending application 20040027283 recites: A device able to provide an estimate of its location comprising:

(1) ranging means for obtaining at least one range measurement from the device to a corresponding reference point;

(2) a receiver for receiving ranging information relating to at least one range measurement from another nearby device to a corresponding reference point; and

(3) a processor for calculating an estimate of the location of the device using both the range measurements obtained by its ranging means and from the ranging information, and the co-ordinates of corresponding reference points, and wherein at least one range measurement obtained from the ranging information was obtained with respect to a reference point to which no range measurements were obtained by the ranging means.

15. Claim 20, dependent on Claim 18 of the Patent recites: A device according to Claim 19 further comprising:

(4) a transmitter for transmitting the estimate of the location of the device to the other nearby device.

16. As underlined above, the limitation of both instant application and the patent recite the exact language. However, the limitations (1), (2), (3) and (4) of the copending application claim range measurement and further calculating the estimated location information. It is clearly that the limitations of (1), (2) and 3 of

the instant application are more specific comparing to the limitation of (1), (2), (3) and (4) are more generic. Therefore, it is clear that Claims 5, 9, 17, 21 – 23 and 40 – 42 of the instant application anticipate Claims 19 – 27 of the copending application.

**17.** "Claims 1, 17 and 40 in the instant application are generic to the species of claim 19 in the copending application. Thus, the generic invention is

"anticipated" by the species of the copending application invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4.

This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354.

Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting."

*(In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).*

**18.** This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**19.** Applicant's remarks/arguments filed on April 25, 2005, with respect to Claims 5, 9, 17, 21 – 23 and 40 – 42 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner had cited relevant

portions of the references as a means to illustrate the system as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims.

**20.** Applicant agrees that Reed et al. disclose “determining location information”, “uses the location estimate of the first transceiver to determine its own location” and “second transceiver use the location information from the first transceiver as a location estimate of the second transceiver”. Applicant also agrees that Reed processes received location information to generate an estimate of the device’s own location; see remarks Page 6 and 7.

**21.** Regarding independent Claims 1, 17 and 40, applicant argued that Reed do not disclose or suggest that “sending a request from the first device to the second device that the second device provide its location to the first device in the event that the first device is unable to determine its location” and “using the location of the second device as an estimate of the location of the first device”. These arguments are not persuasive.

**22.** Reed teaches and describes a method for estimating location of devices from a first device to a second device to provide estimates of devices that do not have location determination capabilities or for the devices that have location

determining means is inoperative. The method is described with a detailed illustrative embodiment (Fig.1, 3-5 and Column 1 line 15 – Column 5 line 55), including the steps of determining the location of a second device located near to the first device (Fig. 3, 4; Column 3 line 6 – Column 4 line 67 and Column 6 line 5 – Column 8 line 45), sending a request from the first device to the second device that the second device provide its location to the first device (Column 2 lines 38 – 56), providing the location of the second device to the first device (Fig.1; column 3 line 6 – Column 4 line 67 and Column 6 line 5 – Column 8 line 45) and using the location of the second device as an estimate of the location of the first device (Fig. 3,4; Column 3 line 6 – Column 4 line 67 and Column 6 line 5 – Column 8 line 45).

**23.** Applicant clearly has failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts. Therefore, the examiner respectfully asserts that CPA does teach or suggest the subject matter broadly recited in independent amended claims 5, 17 and 40. Dependent claims 9, 10, 21 – 23, 41 and 42 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this and previous office action. Accordingly, the rejection for the pending Claims 5, 9, 10, 17, 21 – 23 and 40 – 42 is respectfully maintained.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**24.** Claims 5, 9, 10, 17, 21 – 23 and 40 – 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Reed et al. (U.S. Patent Number 6, 275,707).

**25.** Regarding Claim 5, Reed teaches  
determining the location of a separately housed, second device located near to the first device (Fig.1, 3-5 and Column 1 line 15 – Column 5 line 55);  
sending a request from the first device to the second device that the second device provide its location to the first device in the event that the first device is unable to determine its location (Column 2 lines 38 – 56);  
providing the location of the second device to the first device (Fig.1; column 3 line 6 – Column 4 line 67 and Column 6 line 5 – Column 8 line 45); and

using the location of the second device as an estimate of the location of the first device, wherein the location of the second device is provided to the first device using a wireless communications link (Fig. 3, 4; Column 1 lines 15 – 40 and column 3 lines 6 – Column 4 line 67).

**26. Regarding Claim 17, Reed teaches**

location determining means for determining the location of the second device and providing the location to the first device (Fig. 1, 3-5 and Column 1 line 15 – Column 5 line 55);

wherein the first device is arranged to send a request to the second device that the second device provide its location to the first device in the event that the first device is unable to determine its location (Column 2 lines 38 – 56);

wherein the first device uses the location of the second device as an estimate of its location; and wherein the location of the second device is provided to the first device using a wireless communications link (Fig. 3, 4; Column 1 lines 15 – 40 and column 3 lines 6 – Column 4 line 67).

**27. Regarding Claim 40, Reed teaches**

a transmitter for sending a request for location information to a recipient external to the device in the event that the device is unable to determine its location (Fig. 2 #112, #122 and Column 2 lines 38 – 56);

a receiver for receiving location information from that recipient (Fig. 2 #106, #108 and #122; Column 2 lines 28 – 56); and

a processor for processing received location information to generate an estimate of the devices own location (Fig. 2 #112, Fig. 3 #306 (processing system) and column 3 lines 6 – 44).

**28.** Claims 9, 21 and 41 are rejected as applied above in rejecting claims 5, 17 and 40. Furthermore, Reed teaches wherein the first device comprises location determining means to determine its location; and wherein the request is sent when the location determining means is inoperative (Column 1 lines 46 – 58).

**29.** Claim 23 is rejected as applied above in rejecting claim 17. Furthermore, Reed teaches wherein the first device comprises location determining means to determine its location; and wherein the first and second devices are interchangeable such that they may reciprocate assistance provided by the other (Column 3 line 66 – Column 4 line 24).

**30.** Claims 10, 22 and 42 are rejected as applied above in rejecting claims 9, 21 and 41. Furthermore, Reed teaches wherein the request is sent only when the location determining means is inoperative (Column 1 lines 46 – 58).

***Conclusion***

**24.** Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**25.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any

inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

June 27, 2005.



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